



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/1G342-US1	7566

7590 01/27/2004

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,232

Applicant(s)

TENENBAUM, SAMUEL SERGIO

Examiner

Stephen M Gravini

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-52 and 58-66 is/are pending in the application.
- 4a) Of the above claim(s) 5-10, 17-20, 27-32, 36, 44-49, 59 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65 and 66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66, drawn to a subcombination, classified in class 705, subclass 14.
- II. Claims 5-10, drawn to a subcombination, classified in class 705, subclass 1.
- III. Claims 17-20, 27-32, 44-48, and 64, drawn to a subcombination, classified in class 345, subclass 808.
- IV. Claims 36, 49, and 59, drawn to a subcombination, classified in class 705, subclass 12.

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and groups II-IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the independently claimed invention of group I has separate utility such as a character being displayed on a display screen intrusively in a manner which is unpredictable for a computer system user and is completely beyond a user's control. This specific feature is not found in the other independently claimed invention groups and therefore is considered patentably distinct such that a restriction requirement would appear appropriate. See MPEP § 806.05(d).

Inventions of group II and groups I & III-IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the independently claimed invention of group II has separate utility such as a method of modifying an application program image, without specifically reciting advertising material introduction, so that a user cannot move an introduced display screen multimedia character to a user who cannot move it off the display screen or cover it with other objects wherein the character overlies an existing image with a portion being transparent. This specific feature is not found in the other independently claimed invention groups and therefore is considered patentably distinct such that a restriction requirement would appear appropriate. See MPEP § 806.05(d).

Inventions of group III and groups I-II & IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the independently claimed invention of group III has separate utility such as a method of introducing advertising material through content server and client communications such that a user cannot move an introduced display screen multimedia character to a user who cannot move it off the display screen or cover it with other objects wherein the character overlies an existing image with a portion being transparent without the independently claimed feature of the a character being displayed on a display screen intrusively in a manner which is unpredictable for a computer system user and is completely beyond a user's control. This specific feature is not found in the other

independently claimed invention groups and therefore is considered patentably distinct such that a restriction requirement would appear appropriate. See MPEP § 806.05(d).

Inventions of group IV and groups I-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the independently claimed invention of group III has separate utility such as a method of method of modifying an application program image, without specifically reciting advertising material introduction, so that a user cannot move an introduced display screen multimedia character to a user who cannot move it off the display screen of cover it with other objects wherein the character overlies an existing image with a portion being transparent without the independently claimed feature of the a character being displayed on a display screen intrusively in a manner which is unpredictable for a computer system user and is completely beyond a user's control. This specific feature is not found in the other independently claimed invention groups and therefore is considered patentably distinct such that a restriction requirement would appear appropriate. See MPEP § 806.05(d).

Claims 63-65 are not considered linking claims such that the distinct groups recited above can be examined as a single invention. Please see MPEP 809.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, along with the fact that a different search would be required for each independently claimed distinct group restriction for examination purposes as indicated is considered proper.

Art Unit: 3622

Newly amended claims 5-10, 17-20, 27-32, 36, 44-49, 59, and 64, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

the original presented and examined claims contain features that are not present in the newly amended independent claims such that these features change the scope of the invention and would necessitate a further search in areas beyond the scope of the originally presented invention;

the newly amended independently claimed invention recites features that are not found in the original independently claimed invention;

the newly amended claims do not simplify the invention with respect to clearly defining the patentably distinct features over the originally claimed invention, but rather obscure the patentable features by independently claiming various embodiments through the introduction of at least six independent claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-10, 17-20, 27-32, 36, 44-49, 59, and 64 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was

Art Unit: 3622

not described in the specification such that the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient and message. Those features are considered non-enabling because the recited "changing image which appears on screen intrusively in a manner which is unpredictable for a user and which is completely beyond user control" are not claimed such that one skilled in the art would be able to make or use the invention. That recitation claimed is given the broadest reasonable interpretation consistent with the specification, however the recited feature claimed involves subjectivity, which is considered non-enabling to those skilled in the field of endeavor of applicant's invention. The subjective terms "intrusively," "unpredictable," and "completely beyond user control" are interpreted in light of the specification but do not provide full, clear, concise, and exact term limitation such that the claimed invention is enabling. However, in order to consider these claims in light of the prior art, examiner will assume that these features are enabling by the specification.

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims contain the features of introducing or displaying a

Art Unit: 3622

multimedia animated character into a computer screen and selecting a character, greeting, recipient and message. Those features are considered indefinite because the recited "changing image which appears on screen intrusively in a manner which is unpredictable for a user and which is completely beyond user control" are not claimed such that the features particularly point out and distinctly claim the subject matter which applicant regards as the invention. That recitation claimed is given the broadest reasonable interpretation, however the recited feature claimed involves subjectivity, which is considered indefinite to those skilled in the field of endeavor of applicant's invention. The subjective terms "intrusively," "unpredictable," and "completely beyond user control" are interpreted to many different degrees. What may be intrusive to one might not be so for another (and likewise with respect to unpredictability and user control). However, in order to consider these claims in light of the prior art, examiner will assume that these features are not indefinite by having an antecedent basis from the specification.

Claim Rejections - 35 USC § 102

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 10-222341. Each of the claims in the present application corresponds to claims in those examined applications by foreign patent examining agencies. The examinations by the foreign offices included in the present application filed in March 2003 and May 2003

Art Unit: 3622

discuss the prior art references such that the rejection discussion can be used to reject the current pending claims.

Claim Rejections - 35 USC § 103

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of Juno Online Services (hereinafter JUNO) method of computer multimedia advertising. Since at least 1997, JUNO has performed the claimed method comprising:

introducing or displaying into a computer display screen a multimedia animated character;

sending content from a server to a client and providing a tag communicating to a character controlling server (or media source); and

selecting a multimedia animated character, greeting, recipient and sending the character. Examiner also has personal knowledge of the claimed translational movement, uppermost character display on a multilayer screen, overlaying and transparent charactering, sound display, signal control generation including basis on a user computer, network connectivity and command sending, browser and HTML viewer use, executable code installed in media or file, and payment based on volume or duration access. The claimed introducing or displaying into a computer screen a multimedia animated character occurs when the examiner accessed JUNO's free

Art Unit: 3622

electronic mail account in which the examiner was presented with a multimedia animated character (known as a pop-up advertisement or also known as banner advertising). The claimed sending content from a server to a client and providing a tag communicating to a character controlling server (or media source) occurs when JUNO would gather demographics associated with examiner user response data to send advertisement presentations based on examiner demographic data and correlating that data to advertisers who would historically target that demographic variable data or tag. The claimed selecting a multimedia animated character, greeting, recipient and sending the character occurs when examiner would compose and send an e-mail alerting others to the pop-up advertisement provided by JUNO advertisers. The claimed invention, recited by the applicants, has been provided by JUNO long before the filing of applicants' invention except for the intrusive, unpredictable, and uncontrollable nature of the character. Examiner notes that it is old and well known to those skilled in the art of computer multimedia advertising, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the intrusive, unpredictable, and uncontrollable nature of a character since the intrusive, unpredictable, and uncontrollable feature is merely non-functional descriptive language which is not functionally involved in the steps recited. The introducing or displaying into a computer screen a multimedia animated character would be performed the same regardless of the nature of the character. To one of reasonable skill in the art of computer multimedia advertising, most pop-up advertisements, as

Art Unit: 3622

claimed by the applicant are intrusive, unpredictable, and uncontrollable. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present a multimedia animated character having any type of nature because such a nature does not functionally related to the steps in the invention claimed and because the subjective interpretation of the nature does not patentably distinguish the invention. The motivation to combine applicants claimed invention with the examiner's personal knowledge of JUNO is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

Response to Arguments

enablement and indefiniteness

After careful review of the arguments presented by the applicant, including those issues raised in the declaration of Brad Meyers, further argued by the applicant the enablement and indefiniteness rejections are considered proper and maintained. With respect to the intrusively recitation argued by the applicant, the prior art merely recites "[b]y its nature, advertising is an intrusive rather than voluntary communication with a consumer" (please see column 2 lines 44-46 of US Patent 6,061,659 cited by the

Art Unit: 3622

applicant in paper #15) to describe a subjective opinion with respect to advertising.

That prior art citation is not considered to define a term of art such that applicant's recitation is enabling and not indefinite, because the term "intrusive" mentioned in the prior art merely suggest the context of advertising. In order for one skilled in the art to make or use the claimed intrusively display feature with full, clear, concise and exact terms from the specification, it would be necessary for that term to be indisputably understood and not ambiguous such that what is appealing to one skilled in the art might be an intrusion to others. The intrusively recitation is considered to be non-enabling and indefinite. Likewise, the claim term "unpredictable" applies to the argued differentiated banner ads. Banner ads appear unpredictably to those skilled in the art. A frequently visited web site, such as the New York Times (www.nytimes.com) or the Washington Post (www.washingtonpost.com) electronic newspaper edition demonstrates that banner ads would be displayed in an unpredictable manner as claimed. One skilled in the art would not be able to predict the location of a banner ad of those frequently visited web sites, in the same way as recited in the claim. The unpredictable recitation is considered to be non-enabling and indefinite. Finally, the claim language reciting "completely beyond the user's control" is argued that one skilled in the art could not interpret that removing the electrical power to a computer screen would be beyond the user's control. The recitation "completely beyond" is interpreted to absolutely remove any user control of a display screen. This interpretation is considered reasonable in light of the specification and therefore that claim feature is considered non-enabling and indefinite. The examiner must determine patentability on

Art Unit: 3622

clearly recited and specification discussed claim terms. In this case, those terms are not considered clearly recited such that one skilled in the art could practice the invention using differently interpreted claim language. Those features are considered non-enabling and indefinite as discussed in the rejection above.

interview

Addressing the agreement reached in the interview summary argued by the applicant, the discussed feature may be considered unique in light of the prior art; however the invention as claimed is interpreted to be anticipated or obviated by the prior art.

anticipation

The foreign Office action rejecting the claims under JP 10-222341, which was published August 21, 1998, can be used to reject the claims pending before the US Patent Office. Japanese publication JP 10-222341 discloses a method or system comprising:

introducing into an image produced by an application program on a display screen of a computer system having a graphical user interface, a multimedia character, being introduced so that it appears on the display screen intrusively in a manner which is unpredictable for a computer system user and is completely beyond the user's control while the application program is running, the method utilized in an operating system which produces multiplayer window images on the display screen, said character being

Art Unit: 3622

located in an uppermost layer of the application program window, so that a user cannot move it off the display screen or cover it with other objects (please see the translated Japanese Laid-Open Patent Publication No. 10-222341, filed as paper 15 by the applicant, on the first sentence of numbered paragraph [0013] of page 4, wherein the discussed outputted stored images on the display means of a personal computer to appear then on page 5 of numbered paragraph [0014] wherein the fourth sentence discusses the user does not expect an image to appear on the screen is considered to discuss the claimed image introduction on a computer display screen intrusively unpredictable and beyond the control of the user);

wherein the character moves translationally on the display screen (please see [0014] of said Japanese publication, wherein the disclosed "said character image is displayed to move over the screen along the moving locus is considered to implicitly anticipate the claimed translation character movement);

wherein said character is accompanied by synchronized sound (implied at paragraph [0020] wherein a dancer's dance is set to music which further implies sound as claimed);

sending content from the content server to the client and providing in the content a tag communicating to the character controlling server (please see paragraphs [0022] and [0023] wherein the disclosed locus determining means with communication between personal computers is considered to anticipate the claimed client server content tag communicating);

media source payment (implied in paragraph [0020] wherein the disclosed game award anticipates media source payment as claimed);

characteristic greeting selection (also in [0020] wherein dancer, points, or other programs are selected for a user);

browser commands within an HTML page (implied at [0012] since internet communications are achieved through browser commands using language such as HTML); and

tags or cookies (anticipated by the disclosed character image registering means and moving point recording means).

The interpretation of this foreign reference should more clearly define the anticipatory rejection and arguments raised by the applicant. Although it is argued that the invention is distinguished from the prior art, the Office must broadly construe claims in light of the prior art. The prior art uses terms that are considered to anticipate each of the claimed features.

declaration

With respect to the declaration statement that an examiner assertion does not meet a claimed feature, the claimed feature must be broadly construed. In this case the feature of user control is arguably a feature that can be controlled, such as controlling the power of an electrical display.

Art Unit: 3622

obviousness

In response that the claimed invention is not an obvious variation of examiner's personal experience, an affidavit is submitted with this Office action. Applicant argues that the non-functional descriptive language "intrusive, unpredictable, and uncontrollable nature of the character" patentably distinguishes the invention. In the field of endeavor to which the applicant seeks to patent the claimed invention, opinions of the nature of the character data transmission do not patentably distinguish the invention from the prior art. Opinion claim language directed to an intended use which does not result in a functional or structural difference with respect to the prior art does not serve as a limitation on the claim (please see *In re Scheiber*, 44 USPQ2d 1429 (Fed.Cir. 1997)). In this case examiner considers the recited "intrusive, unpredictable, and uncontrollable nature of the character" to not result in a functional or structural difference with respect to the prior art and therefore does not serve to limit the claim over the prior art. Examiner's personal experience is the prior art as supported by the affidavit *infra* and non-functional descriptive opinion language needs not prior art support for rejection.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30

Art Unit: 3622


p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.**

Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final (703) 872-9327

Official (703) 872-9306

Non-Official/Draft (703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg

January 25, 2004

EXAMINER AFFIDAVIT SUPPORTING OBVIOUSNESS REJECTION

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66 are an obvious variation over examiner's personal knowledge examiner's personal knowledge of Juno Online Services (hereinafter JUNO) method of computer multimedia advertising. Since at least 1997, JUNO has performed the claimed method comprising:

introducing or displaying into a computer display screen a multimedia animated character;

sending content from a server to a client and providing a tag communicating to a character controlling server (or media source); and

selecting a multimedia animated character, greeting, recipient and sending the character. Examiner also has personal knowledge of the claimed translational movement, uppermost character display on a multilayer screen, overlaying and transparent charactering, sound display, signal control generation including basis on a user computer, network connectivity and command sending, browser and HTML viewer use, executable code installed in media or file, and payment based on volume or duration access. The claimed introducing or displaying into a computer screen a multimedia animated character occurs when the examiner accessed JUNO's free electronic mail account in which the examiner was presented with a multimedia animated character (known as a pop-up advertisement or also known as banner advertising). The claimed sending content from a server to a client and providing a tag communicating to a character controlling server (or media source) occurs when JUNO

Art Unit: 3622

would gather demographics associated with examiner user response data to send advertisement presentations based on examiner demographic data and correlating that data to advertisers who would historically target that demographic variable data or tag. The claimed selecting a multimedia animated character, greeting, recipient and sending the character occurs when examiner would compose and send an e-mail alerting others to the pop-up advertisement provided by JUNO advertisers. The claimed invention, recited by the applicants, has been provided by JUNO long before the filing of applicants' invention except for the intrusive, unpredictable, and uncontrollable nature of the character. Examiner notes that it is old and well known to those skilled in the art of computer multimedia advertising, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the intrusive, unpredictable, and uncontrollable nature of a character since the intrusive, unpredictable, and uncontrollable feature is merely non-functional descriptive language which is not functionally involved in the steps recited. The introducing or displaying into a computer screen a multimedia animated character would be performed the same regardless of the nature of the character. To one of reasonable skill in the art of computer multimedia advertising, most pop-up advertisements, as claimed by the applicant are intrusive, unpredictable, and uncontrollable. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present a multimedia animated character having any type of nature because such a nature does not functionally related to the steps in the invention

Art Unit: 3622

claimed and because the subjective interpretation of the nature does not patentably distinguish the invention. The motivation to combine applicants claimed invention with the examiner's personal knowledge of JUNO is to allow advertisers greater targeting capabilities, while transferring information more efficiently, which clearly shows the obviousness of the claimed invention.

I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

Steve Lham